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REMARKS

The Office Action mailed April 27, 2006 has been carefully reviewed and, in view of the above amendments and following remarks, reconsideration and allowance of the application are respectfully requested.

I. Claims Summary

Claims 1-6, 8-18, 20-28, and 31 are currently pending in the application, with claims 1, 15, and 27 being independent claims. Claims 3-4, 9, 11-14, 21, and 23-26 are withdrawn from further consideration. If, however, generic claims upon which the withdrawn claims depend are held to be allowable, the Applicants respectfully request that the withdrawn claims be considered.

II. Office Action Summary

The following claim rejections were submitted by the Examiner in the outstanding Office Action:

- Claims 1-2, 5-6, and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of U.S. Patent Number 3,084,940 to Cissel and U.S. Patent Number 595,494 to O'Meara;
- Claims 8, 15-18, 20, and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of Cissel, O'Meara, and U.S. Patent Number 4,027,885 to Rogers; and
- Claims 1, 2, 5-6, 8, 10, 15-18, 20, 22, 27-29, and 31 are rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of Rogers and O'Meara.

III. Discussion of Claims 1-2, 5-6, 8, and 10

Independent claim 1 recites a golf club having a shaft and a head secured to the shaft. The head includes a primary element at least partially formed of a first material. The primary element defines a first surface and an opposite second surface. The first surface provides an area for engaging a golf ball, and substantially all of the first surface is formed from the first material.

The head also includes a cavity defined by a portion of the primary element that is of unitary construction. The cavity is positioned between the first surface and the second surface, and at least a portion of the cavity extends in a direction that is substantially parallel to the first surface. At least one depression is defined by the primary element and extends toward the second surface from the cavity. In addition, the head includes an insert element formed of a second material and positioned within the cavity. The insert element includes at least one protrusion extending into the depression. The second material is different than the first material, and the second material has a lesser density than the first material.

The Office Action rejects independent claim 1 as being obvious over the combination of Cissel and O'Meara and the combination of Rogers and O'Meara.

The Cissel and O'Meara Rejection

Cissel discloses a golf club head with a substantially vertical slot that receives a plate. In each embodiment of Cissel, the material forming the slot is different than the material forming substantially all of the face (i.e., the portion of the golf club that contacts the golf ball). More particularly, a first portion of the head forms the slot, and a second portion of the head (which forms the face) is attached to the first portion.

According to independent claim 1, the primary element defines a first surface and an opposite second surface. The first surface provides an area for engaging a golf ball, and substantially all of the first surface is formed from the first material. In addition, the primary element defines the cavity. Accordingly, independent claim 1 recites a configuration wherein one element defines the cavity and substantially all of the face. In contrast with independent claim 1, Cissel discloses a configuration wherein two separate, but joined, elements define the slot and the face.

Independent claim 1 also recites that the depression extends toward the second surface from the cavity. Each and every element of the claimed invention must be taught or suggested by the prior art. Even if Cissel is read together with O'Meara, no teaching suggests this specific orientation for the depression.

The rejection combines Cissel and O'Meara for purposes of providing a means to secure the slot and the plate, and the rejection notes that the attachment system is a matter of design choice. As noted previously, the use of a depression/protrusion arrangement may alter the center of gravity of a golf club. That is, the attachment system proposed in the rejection may be more than a mere design choice, and may have an effect upon the characteristics of a golf club. While the Applicants have noted an advantage to the depression/protrusion arrangement, this advantage was not recognized in Cissel. Accordingly, there was no motivation to make the combination proposed in the rejection.

In response to arguments similar to the arguments set forth above, the Office Action states that Cissel shows a surface 4 on the face of the club that is capable of engaging a golf ball. As amended, independent claim 1 recites that substantially all of the first surface is formed from the first material, which is not taught or suggested by Cissel or the combination of Cissel with O'Meara.

The Rogers and O'Meara Rejection

Rogers discloses a golf club head with a slot that receives a filler material. According to Rogers, "The method of manufacture is illustrated in FIG. 4 where the head 14 can be seen to be formed of a two piece construction; the body 15 and the faceplate 37" (Rogers, column 3, line 68 to column 4, line 3). The slot that includes the filler material is formed, therefore, from two joined elements.

According to independent claim 1, the cavity is defined by a portion of the primary element that is of unitary construction. Accordingly, the portion of the primary element that forms the cavity is a one-piece element. In contrast with independent claim 1, and as discussed above, the slot of Rogers is formed from two joined elements.

Independent claim 1 also recites that the depression extends toward the second surface from the cavity. Each and every element of the claimed invention must be taught or suggested by the prior art. Even if Rogers is read together with O'Meara, no teaching suggests this specific orientation for the depression.

The rejection combines Rogers and O'Meara for purposes of providing a means to secure the filler material and the cavity, and the rejection notes that the attachment system is a matter of design choice. As noted previously, the use of a depression/protrusion arrangement may alter the center of gravity of a golf club. That is, the attachment system proposed in the rejection may be more than a mere design choice, and may have an effect upon the characteristics of a golf club. While the Applicants have noted an advantage to the depression/protrusion arrangement, this advantage was not recognized in Rogers. Accordingly, there was no motivation to make the combination proposed in the rejection.

In response to arguments similar to the arguments set forth above, the Office Action states that some polymers have a density greater than the density of some metals (i.e., PTFE and beryllium). As amended, independent claim 1 recites that the second material has a lesser density than the first material, which promotes the upward shift in the center of gravity. This feature is not taught or suggested by Cissel or the combination of Cissel with O'Meara.

Based upon the above discussion, the Applicants respectfully submit that independent claim 1 is allowable over the combination of Cissel and O'Meara and the combination of Rogers and O'Meara. In addition, claims 2, 5-6, 8, and 10 should be allowable for at least the same reasons.

IV. Discussion of Claims 15-18, 20, and 22

Independent claim 15 recites a golf club having a shaft and a head secured to the shaft. The head includes a primary element, a cavity, and an insert element. The primary element is formed of a metal material and defines a face and an opposite rear surface. The cavity is defined by a portion of the primary element that is of unitary construction, and the cavity is positioned between the face and the rear surface. The cavity forms an opening in a lower surface of the primary element and extends only partially between the lower surface and an upper surface of the primary element. The cavity has a substantially constant thickness and extends in a direction between a heel side and a toe side of the head. In addition, the cavity has at least one depression formed in the lower surface and extending toward the rear surface. The insert element is formed

of a polymer material with a lesser density than the metal material and is positioned within the cavity. A portion of the insert element is located within the at least one depression.

The Office Action rejects independent claim 15 as being obvious over the combination of Cissel, O'Meara, and Rogers and the combination of Rogers and O'Meara. The recitation of independent claim 15 includes concepts that are similar to concepts discussed above for independent claim 1. More particularly, independent claim 15 recites that (a) the primary element is formed of a metal material and defines a face and an opposite rear surface, (b) the cavity is defined by a portion of the primary element that is of unitary construction, and (c) the depression extends toward the rear surface. Accordingly, the various arguments presented above for independent claim 1 also apply to independent claim 15.

Independent claim 15 also recites that the cavity forms an opening in a lower surface of the primary element and extends only partially between the lower surface and an upper surface of the primary element. Cissel discloses a configuration wherein a cavity extends entirely through the head, and Rogers discloses a configurations wherein an opening for the cavity is in an upper part of the head. Neither reference discloses, therefore, the combination of (a) an opening in the lower surface and (b) extending only partially from the lower surface of the upper surface.

Based upon the above discussion, the Applicants respectfully submit that independent claim 15 is allowable over the combination of Cissel, O'Meara, and Rogers and the combination of Rogers and O'Meara. In addition, claims 16-18, 20, and 22 should be allowable for at least the same reasons.

V. Discussion of Claims 27-28 and 31

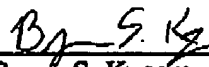
The Office Action indicates that dependent claim 30 would be allowable if rewritten in independent claim format. As amended, independent claim 27 substantially incorporates the recitations of dependent claims 29 and 30. The Applicants respectfully submit, therefore, that independent claim 27 is allowable.

VI. Conclusion

In view of the foregoing, the Applicants respectfully submit that all claims are in a condition for allowance. The Applicants respectfully request, therefore, that the rejections be withdrawn and that this application now be allowed.

This Amendment is being timely filed by facsimile transmission on July 10, 2006. Should fees be deemed necessary for consideration of this Amendment, such fees are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for payment. If anything further is desirable to place the application in even better form for allowance, the Examiner is respectfully requested to telephone the undersigned representative at (503) 425-6800.

Respectfully submitted,

By: 
Byron S. Kuzara
Registration Number 51,255

Banner & Witcoff, Ltd.
1001 G Street, N.W.
Washington, D.C. 20001-4597
Telephone: (202) 824-3000

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